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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,213

03/19/2004

Kazuo Shiota

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EXAMINER

KHAN, USMAN A

ART UNIT

PAPER NUMBER

2622

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DELIVERY MODE

05/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/804,213</p>	<p>Applicant(s) SHIOTA, KAZUO</p>	
	<p>Examiner USMAN KHAN</p>	<p>Art Unit 2622</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,2 and 4-14.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Usman Khan/
Examiner, Art Unit 2622

/Tuan V Ho/
Primary Examiner, Art Unit 2622

Applicant argues that in claims 1 and 11 - 12: Anderson fails to disclose sequence of obtaining image data sets, carrying out classification and/or selection on the image data sets, and recording the image data sets that have been subjected to the classification and/or selection in a recording medium. Also, applicant argues that Anderson fails to teach classifying of data sets according to scene characteristics.

In response the examiner argues that in column 3 lines 5 - 28 Anderson teaches that the system and method comprises a nonvolatile data storage device, a processing unit, a display device, a camera, an input device, and a memory. This system can be considered as an image recording apparatus as a whole there by reading on claims 1 and 11 - 12. More specifically please see the office action mailed on 12/31/2007 and also in column 3 lines 15 - 28 Anderson teaches that the image data sets are preferably stored upon or within an image data set source. Also, examiner notes that Anderson teaches in column 3 lines 15 - 28 that the images are grouped according to temporal, spatial, physical relationship, to be user defined criterion.

Regarding claims 2, 5, and 7: please see the discussion of claims 1 and 11 - 12 above.

Regarding claim 6: applicant argues that Anderson fails to teach that eh selection is carried out first in the case where classification and selection are carried out. please see the office action mailed on 12/31/2007 and also the programmed groups in column 3 lines 15 - 28 are operated in such a manner as the user selects images which are grouped via user defined criterion.

Regarding claims 8 - 9: applicant argues that elements 614(l)-(m) are not recorded in the recording medium in a format that enables display of a slide show. The examiner refers to the office action mailed on 12/31/2007 where the images are displayed and also the examiner notes that the images are recorded in memory as discussed in the discussion of claims 1 and 11 - 12 above.

Regarding claim 10: the examiner feels that this claim is written in an alternative from as follows:

The image recording apparatus according to claim 1, wherein the media recording unit records in the recording medium the image data sets having been subjected to the classification.

Wherein the and/or the selection in a manner that enables printing thereof is omitted.

Even if the applicant believes that the "and/or the selection in a manner that enables printing thereof" is required the examiner notes that images saved in a computer system as in Anderson can be easily printed.

Regarding claim 13: please see the discussion of claims 1 and 11 - 12 above.

Regarding claim 14: examiner refers the applicant to column 3 lines 5 - 28 and column 3 lines 57 - column 4 line 9 depending on the selection of the user newer viewer lists are generated and are different from eh others.

Regarding claim 4: Examiner notes:

Applicant argues that there is no motivation to combine the teachings of Okumura with the teachings of Anderson and AAPA Examiner argues that:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the attorney argues that Okumura teaches away from the other cited references. The examiner responds by saying that the eye closure detector will detect the closure of the eye as claimed in claimed 4. Also, claim 4 is claimed as such that it does not exclude a fixed distance and angle eye closure detecting means. Also the claim does not require multiple persons as claimed.

In response to applicant's argument that there is no motivation to combine the teachings of Okumura with the teachings of Anderson and AAPA the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For the reasons stated above, the rejections for the previous office action will be repeated for 4.